

REMARKS/ARGUMENTS

The application has been carefully reviewed in light of the Office action and Advisory action, and the personal interview with the Examiner and a primary examiner conducted on April 18, 2006, and this response provided thereto.

Claims 1–17 remain in this application. Claim 17 has been allowed.

Applicant's representative discussed the finality of the action of January 20, 2006 with the Examiner and the primary examiner. It was explained that Applicant filed an RCE with a response having substantive claim amendments, and that in such a case, it cannot be said that the claims are directed to the "same invention" as indicated by the Examiner. Accordingly, applicant's representative argued that the rejection was not properly made final. The Examiner and the primary examiner agreed that the action was not properly made final, and agreed to withdraw the finality of the action.

Claim 9 was rejected under 35 U.S.C. § 112 for lack of proper antecedent basis. The claim has been amended, making the rejection moot.

Claims 1–2, 5–7, 12 and 15 were again rejected under 35 U.S.C. § 102(b) as being anticipated by Navco ("Model 1700 System Controller Operating Instructions"). Claims 3, 4, 8, 10–11, 13–14 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Navco. For the following reasons, the rejections are respectfully traversed.

At the personal interview, the Examiner suggested that adding a limitation that the skipping operation was performed without reading the contents of the picture signals, as discussed on page 6 of the specification, would overcome the current rejections. Applicant includes claim amendments with such limitations, and thus the rejected claims are patentable over the art of record.

Regarding the rejection of claim 4, the Examiner takes Official Notice that “ a device for displaying selected images from a continuous stream of images would obviously repeat the selected image in order to prevent a blank screen display”. Applicant disagrees with such a taking of Official Notice. It is not at all clear that displaying a blank screen is necessarily avoided. Thus, applicant challenges that such a feature is well-known. Furthermore, the teaching cited by the Examiner states that if the selected tape “was not recorded by a VCR connected to a Navco System Controller, or other compatible encoding device, sorting is not possible, the image will appear to be frozen when the ‘Thru / Sort’ item is set to indicate ‘Sort.’”. Thus, it appears that the reference teaches that the frozen image is only displayed as a result of sorting not being possible, not the result of the end of a reconstructed image.

Furthermore, the Examiner has not provided the proper motivation for modifying the reference. The burden is on the Examiner to make a prima facie case of obviousness (MPEP § 2142). To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the reference (MPEP § 2143.01).

Merely listing an advantage or benefit of the combination is not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP § 2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP § 2142, last paragraph).

“To reach a proper determination under 35 U.S.C. 103, the Examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made [and] the Examiner must

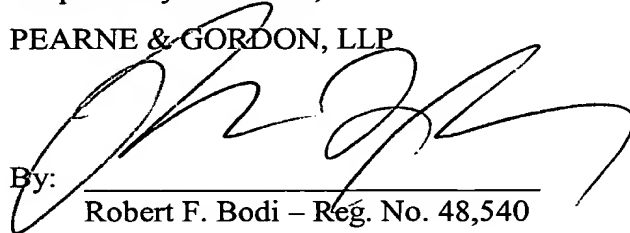
then make a determination whether the claimed invention '*as a whole*' would have been obvious at that time to that person." (MPEP § 2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious "as a whole," not as a piecemeal combination of elements from various references.

Accordingly, the rejection for obviousness is not supported by the Office Action and thus the rejection is improper.

In consideration of the foregoing analysis and claim amendments, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 33828.

Respectfully submitted,
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